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10/591,169

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EXAMINER

RAVETTI, DANTE

ART UNIT

PAPER NUMBER

3685

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/591,169 | <b>Applicant(s)</b><br>MACDONALD ET AL. |  |
|                              | <b>Examiner</b><br>DANTE RAVETTI     | <b>Art Unit</b><br>3685                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/30/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This communication is in response to the Amended Application No. 10/591,169 filed on August 30, 2006.
2. Claims 1-32 canceled by Applicant
3. Claims 33-40 are currently pending and have been fully examined.
4. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

### ***Response to Arguments/Amendments***

5. Clauses (e.g. wherein, whereby, thereby) that merely states the result of the limitations of a claim does not limit the scope of a claim.<sup>1</sup> Therefore, what occurs as a result of sending a notification ("thereby releasing...") and what the method of claim 33 "facilitates", for example, will not limit the scope of the claim.

Applicant's arguments with respect to amended claim(s) have been considered, but are moot in view of new grounds(s) of rejection.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup>***

6. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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<sup>1</sup> (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001); A (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim.

7. Claim 33-40 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to Claim 33, Applicant recites, "...providing at least one voucher to said organization wherein sales of said voucher by said organization is for acquiring said digital media content; receiving confirmation of sale of said at least one voucher to a centralized accounting system transforming said voucher into an activated voucher, sending a notification of said activated voucher to an online or in-store retailer thereby releasing said digital media content to the holder of said activated voucher...." Applicant does not cite when the voucher is received by the user or organizing, and this would not be clear to one of ordinary skill in the art, thereby rendering the scope of the claim(s) unascertainable. See MPEP §2173(d).

Claims 34-40 are also rejected for being dependent upon rejected claim 33. The appropriate correction is required.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 33-40 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claim 33 is directed to a set of method steps, which recites:

providing educational training for members of said organization,  
providing at least one voucher to said organization

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wherein sales of said voucher by said organization is for acquiring said digital media content;

receiving confirmation of sale of said at least one voucher to a centralized accounting system transforming said voucher into an activated voucher,

sending a notification of said activated voucher to an online or in-store retailer thereby releasing said digital media content to the holder of said activated voucher,

providing a download of said digital media content to said holder when said activated voucher is redeemed,

providing a payment to said online or in-store retailer(s) for said digital media content and tracking said voucher and said activated voucher.

Therefore, as the claim(s) are not sufficiently tied to an apparatus, such as a computer, and/or does not transform the underlying subject matter

“...providing educational training for members of said organization, providing at least one voucher to said organization wherein sales of said voucher by said organization is for acquiring said digital media content; receiving confirmation of sale of said at least one voucher to a centralized accounting system transforming said voucher into an activated voucher, sending a notification of said activated voucher to an online or in-store retailer thereby releasing said digital media content to the holder of said activated voucher, providing a download of said digital media content to said holder when said activated voucher is redeemed, providing a payment to said online or in-store retailer(s) for said digital media content and tracking said voucher and said activated voucher.” to a different state. Therefore, the claimed method is non-statutory and therefore rejected under 35 U.S.C. §101.<sup>2</sup>

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<sup>2</sup> Diamond v. Diehr, 450 U.S. 175, 209 USPQ 1 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70, 71 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876). The

Claims 34-40 are also rejected for being dependent upon rejected claim

33. The appropriate correction is required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 33-37 and 39-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser et al., (US 6,385,596) ("Wiser") and in view of Burke, (US 2003/0083930) ("Burke")

**As to claim 33:**

Wiser expressly teaches:

receiving confirmation of sale of said at least one voucher to a centralized accounting system transforming said voucher into an activated voucher (See at least Abstract, (col. 4, lines 60-67), (col. 5, lines 1-15), (col. 8, lines 19-42), (col. 17, lines 20-35), (col. lines 66-67), (col. 19, lines 1-10), Figure 3);

sending a notification of said activated voucher to an online or in-store retailer (See at least (col. 4, lines 60-67), (col. 18, lines 9-23));

wherein sales of said voucher by said organization is for acquiring said digital media content (See at least (col. 4, lines 50-67), Figure 3);

thereby releasing said digital media content to the holder of said activated voucher (See at least (col. 3, lines 5-10), (col. 9, lines 54-67));

providing a download of said digital media content to said holder when said activated voucher is redeemed (See at least (col. 5, lines 1-16), (col. 6, lines 29-47), (col. 8, lines 1-41), (col. 16, lines 4-14), (col. 17, lines 5-21));

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Supreme Court recognize that this test is not necessarily fixed or permanent and may evolve with technological advances;

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providing a payment to said online or in-store retailer(s) for said digital media content (See at least (col. 3, lines 20-32), (col. 4, lines 50-67), (col. 5, lines 41-65), (col. 11, lines 7-15), (col. 13, lines 27-35));

Wiser does not expressly teach:

providing at least one voucher to said organization;

providing educational training for members of said organization;

tracking said voucher and said activated voucher;

However Burke expressly teaches:

providing at least one voucher to said organization (See at least [0003]-[0004]);

Burke does not explicitly recite “providing educational training for members of said organization”; however, Burke does teach “The above outlined method of buying and selling vouchers has numerous limitations. For example, the merchants who offer nonprofit vouchers have to securely print and inventory the vouchers, market the concept, administer the program, and finally sell the vouchers to nonprofit organizations.” [0004]. Therefore, a predictable result of Burke would be the necessity to train their members, on the buying and selling of vouchers. Without the proper training and education of their members, the buying and selling of vouchers could not be economically performed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wiser to include the features of Burke because

The combination of Burk/Wiser does not expressly teach:

tracking said voucher and said activated voucher;

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However, the ability to track vouchers and activated vouchers is a necessity in the use of vouchers. The ability to track vouchers and activated vouchers is an old and well known practice in the art.

**As to claim 34:**

Wiser expressly teaches:

wherein facilitation of said relationship management is among at least one non-profit organization, music providers and said online or in-store retailer (See at least Abstract, Figure 8);

**As to claim 35:**

Wiser expressly teaches:

wherein selling of said voucher by members of at least one non-profit organization generates a fee for said organization (See at least Figure 1B) .

**As to claim 36:**

Wiser expressly teaches:

wherein facilitation of said relationship management includes, but is not limited to, negotiating financial arrangements, marketing, managing relationships, managing and tracking transactions, accounting, developing operational software and web based portals and filtering said digital media content to exclude explicit media (See at least (col. 18, lines 23-35), (col. 20, lines 35-47), (col. 22, lines 6-10);

**As to claim 37:**

Wiser expressly teaches:

wherein developing said operational software and said web based portals includes configuration and branding as a portion of the website of at least one non-profit organization (See at least (col. 1, lines 10-30)).



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**As to claim 39:**

Burke expressly teaches:

wherein providing said educational training includes sales techniques, software and legal implications for sharing said digital media content (See at least Abstract, Figure 1b);

**As to claim 40:**

Burke expressly teaches:

wherein facilitating of at least one non-profit organization includes local non-profit organization units (See at least Abstract, Figure 1b);

**As to claims 1-32:**

Cancelled by Applicant

12. Claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser in view of Burke and in further view of Swartz et al., (US 2003/0132298) ("Swartz").

**As to claim 38:**

The combination of Wiser/Burke discloses as discussed above; however, the combination of Wiser/Burke does not expressly teach:

wherein providing said marketing includes offering of branded complementary products.

However, Swartz expressly teaches:

wherein providing said marketing includes offering of branded complementary products (See at least [0076]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Burke/Wiser to include the features of Swartz

because, in marketing for a particular group of purchasers, based on historical purchasing habits, it is advantageous to provide select purchases of content, with branded complementary products.

14. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the applicant. Although the specified citations are representatives of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Walker et al., (US 2005/0182678); [0163] Generally, in various embodiments, a vending machine processor receives a signal from a vending machine input device (e.g., a keypad, a touch screen, a bar code scanner), where that signal indicates a request to activate a voucher. In some embodiments, one or more databases are used to track whether a voucher is active (as well as, e.g., whether the voucher has been redeemed or has expired). Thus, the database may be consulted such that recipients presenting valid vouchers are provided with appropriate gifts, while recipients presenting inactive or otherwise invalid voucher identifiers are not.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the private

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/Dante Ravetti/

Examiner, Art Unit 3685

Wednesday, November 05, 2008

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685